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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/577,225	05/23/2000	Lundy Lewis	C0441/7159	4215

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LAHIVE & COCKFIELD
28 STATE STREET
BOSTON, MA 02109

EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/577,225	LEWIS, LUNDY	
	Examiner	Art Unit	
	Tan Dean D. Nguyen	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 10-13, 19, 21-27 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 21-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-13 and 30-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/15/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-6, 10-13, 30-33, in the reply filed on 9/14/2005 is acknowledged. The traversal is on the ground(s) that (1) items I and II are sufficiently related, (2) a thorough search and examination of any one claim set would necessarily encompass the search and examination of the remaining claims and (3) these actions can be carried out without serious burden. This is not found persuasive because, groups I and II are distinct, a thorough search/examination of Group I would not necessarily encompass the search/examination of Group II and these two actions would create serious burden to the examiner. For example, Group I calls for 5 steps of:

- “(a) identifying services ...,
- (b) identifying services parameters ...,
- (c.) determining the value of a variable ...,
- (d) monitoring the value of a variable ..., and
- (e) taking action to determine the service level”

while Group II deals with a system associated with a network and comprising 3 receiving steps of:

- “(a) receiving input from a user...,
- (b) receiving input from the user ..., and
- (c.) receiving a request from the user ...

The requirement is still deemed proper and is therefore made FINAL.

Claim Status

Claims 1-6, 10-13, 30-33 are active and are rejected as followed. Claims 19, 21-27 are withdrawn. Claims 7-9, 14-18, 20, 28-29 have been canceled.

Claim Rejections - 35 USC § 112

2. **Claims 1-6, 10-13, 30-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claim 1, it's not clear how the last 3 steps are carried out?

“(c.) determining at least one value of a variable associated with at least one of the service parameter, the component parameter, or a result of the component to service parameter mapping that indicates a service level of at least one of the plurality of services”,

(d) monitoring the at least one value of the variable, and

(e) determining the service level”. The examiner has looked in the specification to see how step (c.) and (e) are determined or carried out, but cannot find any example of these 2 steps are carried out?

3. **Claims 1-6, 10-13, 30-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

(1) In claim 1, lines 6-7, the phrase "services being composed of a plurality of network components" is vague since "service" normally refers to a function (act or step) while "components" normally refer to devices, equipment, computer systems, etc.

(2) In claim 1, lines 7-8, the phrase "the business process being composed of the plurality of services" is vague because it's not clear whether the "services" refer back to the "a plurality of services" on line 5 or different types of services provided by the entity.

(3) In claim 1, lines 10-11, the phrase "or a component to service parameter mapping for at least one of the plurality of services" is vague because it's not clear what this mean?

(4) In claim 1, the 3rd step of "determining at least one value of a variable ... plurality of services" is vague? An example of this step is needed to clarify the point.

(5) In claim 1, the 4th step of "monitoring ... at least one value of the variable" is vague and indefinite? What is the difference between the parameter and the variable? An example of this step is needed to clarify the point.

(6) In claim 1, the last step is vague. How the "determining the service level" is carried out? And what is the action taken in the electronic device? It's not clear the relationship of the last phrase "an acceptable service level of the at least one service is

defined in a service level agreement (SLA)" to the 1st - 4th steps? Isn't the goal of the last step is to meet the acceptable service level as defined in the SLA?

4. Claim 3 recites the limitation "selected ones" in line 2. There is insufficient antecedent basis for this limitation in the claim. Furthermore, it's not clear what this limitation means and how it relates to dep. claim 2 above.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 1-6, 10-13, 30-33 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over BALL et al (US 6,446,200).**

As for independent method claim 1, which deals with a method for providing service level management of a networking service provided to a business Entity by identifying service parameters, determining the value of the service parameters, monitoring the service parameters, and taking action to change the parameters to restore the service to acceptable level as defined in a service level agreement (SLA), BALL et al discloses a similar method for providing service level management for a business process of an entity associated with a network comprising the steps of:

(a) identifying a plurality of networking services for the Entity in carrying out its business {see Figs. 1 "monitoring a TCP/IP Network", 3, 4, 5, 30, col. 2, lines 1-10 "*new level of service-services* ... ", col. 31 "service quality"},

(b) identifying at least 1 of service parameter {i.e. "transmission of data, or flow aggregation and distribution process", "service quality packet loss", see cols. 3-4, Figs. 29A, 29B, col. 31, lines 12-67},

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(c.) determining at least 1 value of a variable associated with at least 1 of the service parameter that indicates a service level {"packet loss", "availability", see {col. 31, line 11 to col. 33, line 65},

(d) monitoring the at least 1 value of the variable {see Fig. 29A, col. 29, lines 5-50}, and

(e) determining the service level in comparison with the level defined in a service level agreement and taking action to meet the agreement level {col. 33, especially col. 34, lines 1-7 "detects, monitors, and audits ... services being delivered"}.

Alternatively, the selection of other service parameters or variables among well known parameters, i.e. components or prices or services (availability, response time, security, etc.) would have been obvious as mere selection of other similar parameters or variables from a limited species of parameters/variables.

As for dep. claims 2-3 (part of 1 above), which deals with well known service level management parameters, i.e. selection of a component parameters, this is non-essential to the scope of the claimed invention and is taught in Fig. 2, 14, col. 31.

Moreover, the phrase "component parameter is capable of" has no patentable weight since it's merely refers to "capacity" and no step/action is taken place or carried out and the component parameter of BALL et al is capable of that.

As for dep. claims 4-6 (part of 1/2 above), which deals with software/software agents utilized to carry out the monitoring or controlling steps, these are inherently included in BALL et al to carryout the management of service with monitoring functions on the Internet system as shown in Fig. 1 or 3. Moreover, these limitation are not

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positive written and are considered as non-functional descriptive material because they further discuss about the component or component parameters but does not specifically describe about the features of the component or component parameters not the steps of "identifying" or "determining value" or "monitoring value".

As for dep. claim 10 (part of 1 above), which deals with a further step of comparing the variable to the service level, this is inherently included in col. 33, line 5 to col. 34, line 6.

As for dep. claims 11-12 (part of 1 above), which deals with further steps of incorporating the SLA and reporting the status of the service, these are taught in col. 33, line 5 to col. 34, line 6, col. 28, lines 59-67.

As for dep. claim 13 (part of 1 above), which deals with well known network component parameters, this is non-essential to the scope of the claimed invention and is taught in Fig. 1, 2, 29A, or 31, or col. 1, line 15 to col. 2, line 10.

As for dep. claims 30-33 (part of 1 above), which deals with well known management monitoring parameters, generating a report or comparing a function or making an adjustment as part of further steps of incorporating the SLA and reporting the status of the service, these are taught in col. 33, line 6 to col. 34, line 6, col. 28, lines 59-67, and col. 28, lines 59-67.

No claims are allowed.

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9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).


In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
Feb. 17, 2006


DEANT. NGUYEN
PRIMARY EXAMINER